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OFFICE OF PETITIONS

In re Application of : DECISION ON PETITION
Sansone et al. : UNDER 37 CFR 1.183
Application No. 10/659794 :
Filing or 371(c) Date: 09/11/2003 :
Attorney Docket No. 08350.1767-00000 :
:

This is a decision on the "Petition Under 37 C.F.R. § 1.183 Requesting Waiver of Signature Requirement for a Non-Signing Inventor," filed March 30, 2011, which is being treated as a petition under 37 CFR 1.183 seeking waiver of 37 CFR §§ 1.67, 1.172, and 1.175 where it requires that a supplemental declaration be executed by the named inventors in a broadening reissue application.

The petition is granted.

BACKGROUND

On September 11, 2003, the present application was filed as an application for reissue of U.S. Patent No. 6,286,615, by inventors Dario Sansone and Ubaldo Puglia, who executed an original reissue declaration.

During the prosecution of the present application, the Office required a supplemental declaration directed to errors in the original patent which were corrected in the present application after the signing of the original reissue declaration.

With the present petition, Applicant has set forth the steps taken to secure the legal representative of joint inventor Puglia's signature on the supplemental declaration. Applicant avers that a copy of the application (U.S. Patent No. 6,286,615) as filed; a copy of the changes made to U.S. Patent No. 6,286,615, and a supplemental reissue declaration were presented to the legal representative of inventor Puglia. However, the legal representative of inventor Puglia has refused to sign the reissue declaration without compensation.

DECISION

35 U.S.C. 251, which is directed to reissue, does not address the signature requirements of a declaration in reissue. 37 CFR 1.172 requires that a reissue declaration be made (and signed) by the

inventors, except as otherwise provided (§§ 1.42, 1.43, 1.47), where the scope of the claims of the original patent is being enlarged. 37 CFR 1.175(b)(1), requires that:

“For any error corrected, which is not covered by the oath or declaration submitted under paragraph (a) of this section, applicant must submit a supplemental oath or declaration stating that every such error arose without any deceptive intention on the part of the applicant.”

37 CFR 1.175(b)(1), taken in conjunction with 37 CFR 1.172, requires a supplemental declaration to be signed by all the inventors. This is because all oaths or declarations necessary to fulfill the rule requirements in a reissue application are taken together collectively as a single oath or declaration. Thus, each oath and/or declaration must bear the appropriate signature of all the inventors. *See In re Hayes*, 53 USPQ2d 1222 (Comm'r Pat. 1999).

37 CFR 1.183 permits, in an extraordinary situation, waiver of a rule which is not a requirement of the statute, where justice requires such waiver, and applicant has requested a waiver of the requirement that the 37 CFR 1.175(b)(1) supplemental declaration be signed by an inventor.

The instant petition is accompanied by an appropriate showing that the legal representative of inventor Puglia refuses to sign the supplemental declaration. Accordingly, the supplemental declaration of March 30, 2011, 2011, signed by inventor Sansa, will be accepted as though it was signed by joint inventors Sansa and the heir and legal representative of deceased inventor Puglia as required by 37 CFR 1.175(b)(1) taken in conjunction with 37 CFR 1.172. *See MPEP 602.02. See In re Hayes, supra.*

CONCLUSION

The present petition is granted.

Jurisdiction over the application is forwarded to Technology Center Art Unit 3611 for further examination and prosecution.

Please direct any questions related to this decision to Attorney Derek Woods, at (571) 272-3232.

/Hiram H. Bernstein/
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